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EXAMINER

JOHNSON, BLAIR M

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3634



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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/205,318

Filing Date: December 04, 1998

Appellant(s): LEPAGE ET AL.

Paul B. Stephens
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/30/03.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 20-27 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 20-27 are rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 14.

(11) Response to Argument

The invention involves a roller door having tapered side edges which ride up and down in guides which diverge from top to bottom.

The critical limitations that are present in the patent claims (5,579,820) that Appellant is attempting to remove from the present claims are the tapering of the closure (roller door) and the guide means which diverge from top to bottom, both of which are related since the closure conforms to the guides. These limitations were present in the originally filed patent claims in some form but were further amended (narrowed) by patent owner on 5/30/96, the only amendment of the patented case.

In the remarks section of that amendment, patent owner proceeded to argue the merits of these two features, "tapering" and "diverging". In addressing the shortcomings of the prior art, patent owner continuously argues the importance of these features. In addressing Wellens (the only reference actually applied in the rejection), he states on page 6, lines 13-15, that "In the present invention, the section closing the trapezoidal opening is complementary in shape thereto and thus cannot be fairly compared to the Wellens system", the Wellens system which includes a screen which is "*vertically* guided along guide tracks", page 6, line 1, emphasis **not** added. He further states: "In

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fact, Claim 1 is considered to clearly distinguish from the Belgium Patent by claiming that the section of the flexible closure closing the shelter opening has side edges tapering towards the overhead roller provided at the narrow end of the shelter opening", page 6, lines 15-19. This is a clear indication that Applicant fully considered that the "diverging" feature rendered his claim allowable.

Regarding Applicant's remarks concerning both Ojima et al and German patent No. DE-38 41 139-A, he further stresses the level of importance of the "diverging" feature to overall patentability by stating that while these references do have diverging sides and guides, they differ in other structural ways, i.e. location of the roller. He states on page 7, lines 6-8, that these two references show the roller at the "large end of a trapezoidal opening as opposed to the device of the present invention which is, and must, be installed at the narrow end thereof", emphasis **not** added. Again, emphasis is put on the patentability of the "diverging" feature.

Regarding German, he again states that the closure is a "constant span", emphasis **not** added, and also addresses the "large" end verses the "narrow" end of the opening, as discussed above.

On page 8, Applicant summarizes his view of the patentability of claim 1 over the prior art as being attributable to the "tapering section", the prior art having "rectangular" closures, etc. He states "Accordingly, Claim 1 has been herein amended in order to clearly distinguish from the citations and, more particularly, by reciting that the flexible closure includes a

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tapering section adapted to substantially completely close the door opening and to wind around an overhead roller provided at the upper, i.e. narrow, end of the door opening".

Consequently, it is clear from the specifics discussed above, as well as from the general view expressed by Applicant in the remarks of 5-30-96, that the diverging sides of the closure and the diverging guide means are the primary, and essentially only, feature which renders the claims allowable. Removing these features from the claims would be an attempt to recapture claimed subject matter.

Of critical importance is language added by way of Examiner's amendment of 6/10/96 by which was added "thereby diverging from top to bottom" in limiting the guide means. It is implicit that the Examiner considered this to be the patentable feature and, by accepting such language, such was agreed by patent owner.

Office policy is directed by decisions: Pannu V. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 and Ex Parte Eggert, Appeal no. 2001-0790).

Among the criteria for evaluating recapture, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. (Pannu). The "tapered" and "diverging" features, now omitted, were both amended and argued, as carefully detailed above. It is to be emphasized

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that these features have not been broadened, they have been omitted altogether. An Examiner's amendment, consented to by then Applicant, may be used to establish surrender claimed subject matter on which to base recapture (Yamaguchi).

MPEP 1412.02 is very clear that arguments alone can establish surrendered subject matter. Again, this applies to the present facts.

To repeat, patent owner both argued the omitted limitations as being critical to patentability and further amended the claims in this regard, through his amendment and the Examiner's amendment upon which he agreed.

Appellant's arguments suggests that since patent owner argued other limitations as lacking in the prior art, that this emphasis negates the importance of the omitted "tapering" and "diverging" features. This simply has not bearing on the determination of recapture as presented. He also argues that additional limitations are being added in the reissue claims. However, since such features are not related to those omitted, such an argument falls short. (Pannu).

On page 11 of the brief, Appellant states "That the question for reissue is not whether the excluded subject matter was necessary for patentability of the original claims.", and that "that could not be the case here, as the examiner has confirmed that the present claims excluding these 'points of novelty' are indeed patentable". However, the present claims have added limitations that render them patentable, as evident from

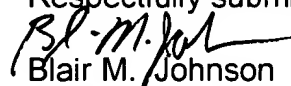
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the record.

In view of the facts of the case and the remarks presented above in support thereof, it is believed that the Examiner should be affirmed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Blair M. Johnson
Primary Examiner
Art Unit 3634

BMJ
September 16, 2003

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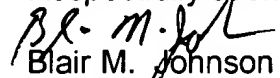
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